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Our Reference: BC-122-C

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Richard C. Wilson and Patrick M. Culpepper  
Serial Number: 09/391,294  
Filing Date: September 7, 1999  
Examiner/Art Group Unit: R. Canfield/3635  
Title: CORNER POST SUPPORT MEMBER

SUPPLEMENTAL APPEAL BRIEF

Assistant Commissioner of Patents  
Washington, D.C. 20231

Sir:

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Please enter this Supplemental Appeal Brief which is a response to the Order mailed February 28, 2002 by the Board of Patent Appeals and Interference (Board).

BACKGROUND

In the Appeal Brief submitted on March 21, 2001, two issues were on appeal. Issue No. 1 was whether claims 1 - 5 have been properly rejected under 35 U.S.C. § 257 as being improper recapture of broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based. The Board now requires this Supplemental Appeal Brief to address the impact of Panner v. Storz Instruments, Inc., 258 LF. 3d 1366, 59 USPQ 2d 1597 (Fed. Cir. 2001) which was decided on July 25, 2001, after submission of the Applicant's Appeal Brief.

Issue No. 2 was whether claims 1, 2, and 4 - 5 are unpatentable under 35 U.S.C. § 102(b) over U. S. Patent No. 2,091,316 issued to Hancock. Issue No. 2 will not be addressed in this Supplemental Appeal Brief.

ISSUE

What is the impact of the Pannu decision on whether claims 1 - 5 have been properly rejected under 35 U.S.C. § 257 as being improper recapture of

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broadened claim subject matter surrendered in the application for the patent upon which the present reissue is based.

#### ARGUMENT

According to the Pannu decision, the Applicant is estopped from attempting to recapture the precise limitations he added to overcome prior art rejections. The precise limitations added in prosecuting the Applicant's U. S. Patent No. 5,664,376 ('376) that overcame the prior art rejections were that: the support member has first and second support flanges extending outwardly from first and second portions of a single member, respectively, and the first and second flanges extend continuously along the entire length of the first and second portions.

The aforementioned limitations were the precise limitations added to overcome the prior art rejection. Any other limitations added to the claims in prosecuting '376 were at the most only an attempt to overcome prior art rejections. The Pannu decision does not state that the Applicant is estopped from attempting to recapture the precise limitation he added in an unsuccessful attempt to overcome prior art rejections. In other words, Pannu decision does not estop the recapture of limitations that did not overcome the prior art rejections.

The Examiner, during the prosecution of '376, indicated to the Applicant what precise limitations were necessary to overcome the prior art rejections in the Notice of Allowance. The Applicant has not attempted to recapture these precise limitations, but in fact has added new claim 5 requiring the precise limitations as stated by the Examiner.

The Pannu decision does not address the factual situation of the present case where the Examiner, in prosecuting '376, lists through the Examiner's Interview Summary Record (Appendix B in the Appeal Brief) and cited in the Examiner's Amendment which accompanied the Notice of Allowance (Appendix C2 and C1, respectively, in the Appeal Brief) what the precise limitations were to overcome the cited prior art. There is no evidence that the Pannu court had any information from the Prosecuting Examiner of U. S. Patent 4,435,855 what were the precise limitations

in the claims that overcame the prior art. Therefore, the Pannu court was under the default assumption that all limitations added to the claims were to overcome the prior art rejections; and therefore subject to the recapture rule. However, in the subject case, the Examiner provided a list in the Examiner's Amendment of the precise limitations in the claims that overcame the prior art rejections and are subject to the recapture rule.

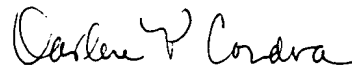
Therefore, the Pannu decision is not controlling with respect to the issues before the Board.

If any charges are required, please charge them to Deposit Account No. 25-0115.

This Supplemental Appeal Brief is being filed in triplicate including one original and two copies.

Respectfully submitted,

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